

REMARKS

OFFICE ACTION

The Abstract is objected to as indicated.

The specification, excluding the claims, is objected to and a substitute specification has been required, as indicated.

Claims 1-15 are pending in the application.

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Yuasa et al. (JP 11 (1999)-95694A).

The Examiner has made a 37 CFR 1.105 Requirements for Information.

The Office Action objections and rejections are hereby traversed. No new matter has been added in this response.

FOREIGN PRIORITY CLAIM

The priority information paragraphs in page 2 of the Office Action are misplaced, because the paragraphs suggest insertion of a reference to the prior application in the first sentence of the specification. However, 37 CFR 1.55 governs foreign priority. In the present Application, foreign priority to Japanese application no. 2000-198544 filed June 30 2000 as governed by 37 CFR 1.55 was presented, for example, in the Declaration filed with the Application on December 15, 2000 and with submission of the prior foreign application on December 15, 2000, as acknowledged by the Examiner in page 3 of the Office Action. Removal of the misplaced priority paragraphs from the Office Actions is requested.

SPECIFICATION OBJECTION AND 35 USC 112, FIRST PARAGRAPH, REJECTION

Page 9 of the Office Action is the Response to Arguments. The Office Action maintains,

from the previous Office Action, objections to the specification for including “idiomatic English.” The objections are traversed as follows:

Generally, US law governing the patent specification is set forth in 35 USC 112. For example, 35 USC 112, first and second paragraphs, respectively, provide:

35 USC 112, first paragraph: The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 USC 112, second paragraph: The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

So the law is based upon whether one skilled in the art can understand the patent specification and whether the claims particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

OBJECTION TO ABSTRACT OF DISCLOSURE

The previously submitted new replacement abstract is objected for containing “idiomatic English,” for example, in line 1, “system using auction has ...” It is understood that the Examiner is alleging that this expression, as well as other specification objections, is an *improper* idiomatic English, because “idiomatic English” would be acceptable under US law (37 CFR 1.152(b)(1)(ii)). Correction of the Office Action is respectfully requested.

Regarding the Abstract, the Examiner appears to suggest that the expression should be corrected to “system using an auction has ...” However, the Applicant asserts that one skilled in the art would readily understand that “a system using auction” has a meaning of a system accommodating one or more auctioning processes, so the expression is in proper idiomatic English as well as definite. Further, an article affix can be omitted according to idiomatic English. In other words, the omission of the article “an” is not an improper idiomatic English in this case.

Further, the Examiner relies on MPEP 608.01(b), however, the Abstract meets the proper language and format pursuant to the MPEP guidelines by not exceeding 150 words, by avoiding form and legal phraseology such as “means” and “said,” by not repeating information given in

the title, by avoiding phrases which can be implied, such as "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. Therefore, the Abstract is proper and withdrawal of the objection to the Abstract is requested.

In particular, the objection to the Abstract and similar objection(s) to the specification is hereby traversed and withdrawal of the same is respectfully requested, because the specification is in idiomatic English, it is definite, and understandable by one skilled in the art to satisfy 35 USC 112.

REQUIREMENT FOR SUBSTITUTE SPECIFICATION AND ENABLEMENT
REJECTION

The Examiner maintains from the previous Office Action that "A substitute specification excluding the claims is required pursuant to 37 CFR 1.125(a) because it is replete with idiomatic English" (page 4 of the Office Action). The Examiner in page 4 of the Office Action newly provides "Examples of idiomatic English," which the Applicant understands to be alleged *improper* idiomatic English. It is understood that essentially the Examiner is alleging that the specification is referring to "language not known or used in the art of Advertising" and, thus, in *improper* idiomatic English (see, Office Action, page 5, lines 14-15, and the examples of alleged improper idiomatic English provided in the paragraph spanning pages 4-5 of the Office Action), which would also be related to the 35 USC 112, first paragraph, rejection of non-enablement, because the Examiner is alleging that one skilled in the art could not make and use the claimed invention based upon the specification, presumably because the specification is not in full, clear, concise, and exact terms by referring to "language not known or used in the art of Advertising."

In particular, claims 1-15 are rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. For example, the Office Action in page 6 beginning at line 2, alleges:

Specifically, claims 1-15 do not enable one of ordinary skill in the art to use the invention as it is not enabled for an "advertisement tenant" while page 6 defines the "tenant" the definition is vague at best. The advertising medium is not enable for a "car" as indicated in the specification on page 6.

The Applicants respectfully assert that the specification fully, clearly, concisely, and in exact terms describes the claimed present invention as being related to digital contents advertising. Nevertheless, the specification is amended for clarity taking into consideration the

Examiner's comments.

The present invention relates to an advertisement display system for determining a sponsor of an advertisement tenant ***contained in digital contents ~~offer~~ a medium capable of transmitting/receiving the digital contents as a digital image, such as the Internet and a digital TV***, by auction. In particular, the present invention relates to an advertisement display system in which the degree of attention to advertisement is adjusted by using an advertising character (page 1, lines 6-11 of the present Application).

It is readily apparent to one skilled in the art that the claimed present invention relates to determining an "advertisement tenant" for a digital content. In other words, the expression "determining a sponsor of an advertisement tenant ***contained in digital contents ~~offer~~ a medium capable of transmitting/receiving the digital contents as a digital image, such as the Internet and a digital TV***, by auction" and the expression "a digital contents advertisement display system" (page 1, lines 6-11 and page 5, lines 29-32), clearly describe that "advertisement tenant" is related to becoming a digital occupant of a digital advertisement space included in a digital content, in form of "a billboard shown in the outline of contents, articles such as a car and magazine used in the contents, or a character used in the contents" (page 7, lines 2-4 of the present Application). One skilled in the art would understand that "advertisement tenant" in the claimed present invention relates to a digital tenant, and the claimed present invention is related to finding an advertiser ("sponsor") to become a digital tenant, or a digital occupant, for a digital content. In other words, a digital content can contain one or more digital advertisement tenants 22, 21 (default tenant - dependent claim 4), 23, as expressly shown in FIG. 2 of the present Application.

Further, the claimed present invention provides finding such an advertiser to become an "advertisement tenant" via an auction. It is readily apparent that the specification uses art-accepted terminology that is enabling and in proper idiomatic English. In other words, the claimed present invention provides auctioning an advertisement space, or auctioning to become an advertisement tenant, in a digital content.

Page 6, line 31 to page 7, line 4 of the present Application (as amended) clearly provides:

Reference numeral 2 denotes an advertisement tenant bidding part for presenting a price at which an ***advertisement sponsor desires to provide advertisement*** ~~with respect to~~ by

becoming an advertisement tenant shown in the disclosed outline of digital contents. Herein, an advertisement tenant refers to a billboard shown in the outline of contents, articles such as a car and a magazine used in the contents, or a character used in the contents.

More specifically, the advertisement tenant used in the contents may have its display character and the like updated, depending upon the requests of an advertisement sponsor, whereas the scenario of the contents remains the original one and is not updated. Accordingly, bidding is conducted, predicated on that an exposure frequency of each advertisement tenant in the contents is nearly equal to that of the disclosed outline of contents.

Page 9, lines 4-9 of the present Application also provide:

In general, an advertisement tenant is present in various manners. More specifically, it is a billboard displayed in the background, a building structure, a character, and the like. Thus, for example, an operation of updating display contents, such as providing an article name of an advertising object of a sponsor in the billboard displayed in the background, and changing a character to an article character, is required.

Accordingly, the terms or phrases or modes of characterization used to describe the invention are sufficiently consonant with the art to which the invention pertains, or with which it is most nearly connected (e.g., digital auction processes to auction an advertisement space, or auction to become an advertisement tenant, in a digital content), to enable one skilled in the art to make and use the invention, such that claims 1-15 are enabled under 35 USC 112, first paragraph, and for the examiner to make the examination specified in 37 CFR 1.104 so that the objection to the specification under 37 CFR 1.125 is also not appropriate.

According to the foregoing, rejection of claims 1-15 under 35 USC 112, first paragraph, is not appropriate and also the requirement for a substitute specification is not appropriate. Withdrawal of the same is respectfully requested.

35 USC 112, SECOND PARAGRAPH, REJECTION

Claims 1-15 are also rejected under 35 USC 112, second paragraph, for indefiniteness. The Office Action alleges that the expression "advertisement tenant" is indefinite, because the specification does not clearly redefine the term. However, as discussed above, "advertisement tenant" is related to becoming a digital occupant of a digital advertisement space included in a digital content, in form of "a billboard shown in the outline of contents, articles such as a car and

magazine used in the contents, or a character used in the contents" (page 7, lines 2-4 of the present Application). One skilled in the art would understand that "advertisement tenant" in the claimed present invention relates to a digital tenant, and the claimed present invention is related to finding an advertiser ("sponsor") to become a digital tenant, or a digital occupant, for a digital content.

Further, contrary to the Office Action rationale on page 7, the claims are not narrative and indefinite, and the expression "using auction" and a "winner sponsor" are definite, because one skilled in the art would understand, as also evidenced by the Examiner's suggested corrections, that "using auction" has a meaning of using an auction process and the term a "winner sponsor" has a meaning of a sponsor who has won the auction. In other words, the claims are clearly in idiomatic English and acceptable under 35 USC 112, second paragraph, and 37 CFR 1.52.

Nevertheless, the claims, using independent claim 1 as an example, are amended for clarity taking into consideration the Examiner's comments and are not narrower than the originally filed claims, as follows:

1. (CURRENTLY AMENDED) A digital contents advertisement display computer system using auction, comprising:
 - a computer processor; and
 - a computer readable medium storing at least one computer program controlling the computer processor to control the digital contents advertisement display computer system according to a process comprising:
 - disclosing an outline of digital contents to be distributed through a digital medium to audiences;
 - allowing the audiences, as sponsors, to bid for becoming an advertisement tenant contained in the disclosed digital contents;
 - determining a ~~winner~~winning sponsor for the advertisement tenant from among the bidding sponsors, according to a highest price bid by a sponsor; and
 - ~~completing~~updating the digital contents to contain the advertisement tenant, contained in the contents according to requests from the winning sponsor, to complete the digital contents for distribution, wherein the completed digital contents as distributed function as an advertising medium.

Support for the claim amendments can be found, for example, in page 8, line 32 to page 9, line 19 of the present Application.

Further, support for the claimed present invention can be found, for example, in FIG. 2 and page 7, lines 11-16 of the present Application:

For example, a car 21 and an artificial creature 22 used as tools of the contents are displayed on a screen as shown in Figure 2. In this case, the car 21 and the artificial creature 22 are advertisement tenants. For example, in the case where a car provided by an advertisement sponsor, which has won the car 21 by bidding, is a car 23, contents in which the car 21 is replaced by the car 23 will be distributed.

The claims particularly point out and distinctly claim, “allowing the audiences, as sponsors, to bid for **becoming an advertisement tenant contained in the disclosed digital contents**; determining a **winnerwinning sponsor** for the advertisement tenant **from among the bidding sponsors, according to a highest price bid by a sponsor**; and ~~completing~~**updating the digital contents to contain the advertisement tenant**, ~~contained in the contents~~ according to requests from the winning sponsor, to complete the digital contents for distribution, **wherein the completed digital contents as distributed function as an advertising medium**” (e.g., independent claim 1).

Regarding the indefiniteness rejection of dependent claim 4, in FIG. 2, the displayed car image 21 is a default advertisement tenant.

Regarding the indefiniteness rejection of dependent claim 5, a displayed character is a type of advertisement tenant, whose behavior can be controlled depending on price, for example, to attract more attention. Support can be found, for example, in FIG. 2, character 22, and page 11, line 22 to page 12, line 11 of the present Application.

Accordingly, claims 1-15 particularly point out and distinctly claim the subject matter which the applicant regards as the invention, and are definite under 35 USC 112, second paragraph.

35 USC 102(B) REJECTION

Claims 1-15 are rejected as being anticipated under 35 USC 102(b) by Yuasa (JP 11-095694). Yuasa discusses, “To grasp the degree of the propagation of the advertisement objectives of an advertiser and the degree of the interest in the advertisement of users by detecting the inputs from users and outputting the display contents so as to simultaneously display the detailed information of a main service and the detailed advertisement information in

accordance with the detection results” (Abstract and pages 1-2 of the English translation).

However, it is readily apparent that Yuasa relates to providing detailed advertisement information and detecting degree of interest of users, but fails to disclose or suggest the claimed present invention's, “allowing the audiences, as sponsors, to bid for **becoming an advertisement tenant contained in the disclosed digital contents**; determining a **winnerwinning sponsor** for the advertisement tenant ***from among the bidding sponsors, according to a highest price bid by a sponsor.***”

In other words, Yuasa does not discuss any auctioning process. Accordingly, Yuasa cannot anticipate the claimed present invention, and withdrawal of the prior art rejection of Yuasa and issuance of an allowance or a new non-final office action over any newly relied upon prior art is respectfully requested. The independent claims 1 and 15, particularly point out and distinctly claim a computer based auctioning of an advertisement space, or auctioning to become an advertisement tenant, in a digital content, and Yuasa is clearly silent on any type of auctioning.

The claim amendments are not amendments to overcome Yuasa, so that any new grounds of rejections would not be necessitated by the claim amendments, and a final office action would be premature by not affording the Applicant any opportunity to respond to any newly relied upon prior art.

REPLY TO REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105

The Office Action in page 11 also provides a Requirement for Information Under 37 CFR 1.105 (Requirement).

This is a reply to the Requirement for Information pursuant to 37 CFR 1.105:

First, the Requirement in item 7 sets a shortened statutory period of two (2) months for a reply. However, MPEP 704.13 guideline suggests that when the Requirement is sent with an Office Action on the merits, as in the present Office Action of June 28, 2005, and not as a separate Office Action, the Requirement will be given the same period for reply as the action on the merits. Accordingly, it is understood that the Requirement has a period for response set to expire on September 28, 2005 or three months from the mailing date of June 28, 2005 of the Office Action on the merits. Therefore, this reply to the Requirement is timely filed.

Second, it is understood that in the Requirement (Office Action, page 11) enumerated items 3 and 4, specify the scope of the information requested, and complete reply to each enumerated requirement is provided, as follows:

REQUIREMENTS FOR INFORMATION - 3. In response to this requirement, please provide where in the specification is the foundation for the newly submitted claims.

The specification fully, clearly, concisely, and in exact terms describes the claimed present invention as being related to digital contents advertising. The foundation for the claims 1-15 can be found, for example, in page 1, lines 6-11 (as amended), of the present Application:

The present invention relates to an advertisement display system for determining a sponsor of an advertisement tenant ***contained in digital contents ~~offer~~ a medium capable of transmitting/receiving the digital contents as a digital image, such as the Internet and a digital TV***, by auction. In particular, the present invention relates to an advertisement display system in which the degree of attention to advertisement is adjusted by using an advertising character.

It is readily apparent to one skilled in the art that the claimed present invention relates to determining an "advertisement tenant" for a digital content. In other words, the expressions "determining a sponsor of an advertisement tenant ***contained in digital contents ~~offer~~ a medium capable of transmitting/receiving the digital contents as a digital image, such as the Internet and a digital TV***, by auction" and "a digital contents advertisement display system"

(page 1, lines 6-11 and page 5, lines 29-32), clearly describe that “advertisement tenant” is related to becoming a digital occupant of a digital advertisement space included in a digital content, in form of “a billboard shown in the outline of contents, articles such as a car and magazine used in the contents, or a character used in the contents” (page 7, lines 2-4 of the present Application). One skilled in the art would understand that “advertisement tenant” in the claimed present invention relates to a digital tenant, and the claimed present invention is related to finding an advertiser (“sponsor”) to become a digital tenant, or a digital occupant, for a digital content. In other words, a digital content can contain one or more digital advertisement tenants 22, 21 (default tenant - dependent claim 4), 23, as expressly shown in FIG. 2 of the present Application.

Further, the claimed present invention provides finding such an advertiser to become an “advertisement tenant” via an auction. In other words, the claimed present invention provides auctioning an advertisement space, or auctioning to become an advertisement tenant, in a digital content.

Page 6, line 31 to page 7, line 4 of the present Application (as amended) clearly provides:

Reference numeral 2 denotes an advertisement tenant bidding part for presenting a price at which an ***advertisement sponsor desires to provide advertisement with respect to by becoming an advertisement tenant shown in the disclosed outline of digital contents***. Herein, an advertisement tenant refers to a billboard shown in the outline of contents, articles such as a car and a magazine used in the contents, or a character used in the contents.

More specifically, the advertisement tenant used in the contents may have its display character and the like updated, depending upon the requests of an advertisement sponsor, whereas the scenario of the contents remains the original one and is not updated. Accordingly, bidding is conducted, predicated on that an exposure frequency of each advertisement tenant in the contents is nearly equal to that of the disclosed outline of contents.

Page 9, lines 4-9 of the present Application also provide:

In general, an advertisement tenant is present in various manners. More specifically, it is a billboard displayed in the background, a building structure, a character, and the like. Thus, for example, an operation of updating display contents, such as providing an article name of an advertising object of a sponsor in

the billboard displayed in the background, and changing a character to an article character, is required.

Accordingly, the terms or phrases or modes of characterization used to describe the invention are sufficiently consonant with the art to which the invention pertains, or with which it is most nearly connected (e.g., digital auction processes to auction an advertisement space, or auction to become an advertisement tenant, in a digital content), to enable one skilled in the art to make and use the invention.

REQUIREMENTS FOR INFORMATION 4. In response to this requirement, please state the specific improvements of the claimed subject matter in claims 1-15 over the disclosed prior art and indicate the specific elements in the claimed subject matter that provide those improvements. For those claims expressed as means or steps plus function, please provide the specific page and line numbers within the disclosure which describe the claimed structure and acts.

First, the specification's Description of the Related Art adequately describes the background of the disclosed subject matter. For example, page 1, line 22 to page 2, line 7, discuss FIG. 10, which shows a schematic structure of a conventional digital contents advertisement display system, and discuss FIG. 11, which illustrates a conventional banner display. Further, page 2, lines 8-9, expressly provides, "However, the above-mentioned conventional advertising method has the following problems," and discusses the problems in page 2, lines 10-22, such that it is readily apparent that the present application adequately describes the background of the disclosed subject matter.

Second, regarding the requirement of "state the specific improvements of the claimed subject matter in claims 1-15 over the disclosed prior art and indicate the specific elements in the claimed subject matter that provide those improvements," page 2, lines 25-29, expressly provides an improvement of the claimed present invention, which "allows an advertisement sponsor and a content creator to directly deal with each other, and enables an advertising cost to be laid down in accordance with advertising effects." The specific claim elements directed to the improvements and in contrast to the prior art, are (in unlimiting examples), (1) "allowing the audiences, as sponsors, ***to bid for becoming an advertisement tenant*** contained in the disclosed digital contents; (2) ***determining a winnerwinning sponsor*** for the advertisement tenant from among the bidding sponsors, ***according to a highest price bid by a sponsor,*** (3) and ***completingupdating the digital contents to contain the advertisement tenant,*** contained in the contents ***according to requests from the winningwinner sponsor,*** to

complete the digital contents for distribution, wherein the completed digital contents as distributed function as an advertising medium” (e.g., amended independent claim 1, emphasis added). See also, independent claim 15.

Dependent claims 2-14 recite patentably distinguishing features of their own and further are patentably distinguishing at least due to their dependencies from independent claim 1. For example, in contrast to the disclosed prior art:

Dependent claim 2 provides, “wherein the process of the at least one computer program further comprises receiving an input from an audience and allowing the audience to influence a scenario process of the contents,”

Dependent claim 5 provides, “wherein the process of the at least one computer program further comprises controlling behavior of a character displayed on a screen in accordance with a bidding price by a sponsor, wherein the character behaves so that the audience pays more attention to the advertisement tenant for which the bidding price is higher,”

Dependent claim 7 provides, “recording an access log with respect to the character, and calculating a degree of attention to the advertisement tenant based on the access log recording, wherein advertising effects can be measured based on the calculated degree of attention to the advertisement tenant,”

Dependent claim 9 provides, “wherein the process of the at least one computer program further comprises changing a display of the advertisement tenant so that a degree of attention to the advertisement tenant in the contents is changed in accordance with a bidding price,”

Dependent claim 11 provides, “wherein the degree of attention to the advertisement tenant is changed by using a displayed character on a screen,” and

Dependent claim 13 provides, “wherein the process of the at least one computer program forms an auction of the advertisement tenant contained in the contents to the advertisement sponsors and the process of the at least one computer program further comprises auctioning again the advertisement tenant of the contents, if the contents are redistributed.”

Third, regarding the requirement, “For those claims expressed as means or steps plus function, please provide the specific page and line numbers within the disclosure which describe the claimed structure and acts,” claims 1-15 are not expressed as means or steps plus function, such that the requirement would not specifically apply. Although, the forgoing discussions clearly set forth support for the claims via specification page and line numbers.

It is believed that this reply to the Requirement is a complete reply to each enumerated requirement for information by giving the information pursuant to 37 CFR 1.111.

CONCLUSION

The claim amendments are not amendments to overcome Yuasa, so that any new grounds of rejections would not be necessitated by the claim amendments, and a final office action would be premature by not affording the Applicant any opportunity to respond to any newly relied upon prior art. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Respectfully submitted,
STAAS & HALSEY LLP

Date: September 28, 2005

By: _____


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